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Opposition no. 91153135

Application SN 76/085,778

Published July 30, 2002

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BOX TTAB NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington VA 22202-3513

For its response to the motion of Applicant served by mail apparently on November 20, 2002, Opposer Blueair Inc. timely and respectfully opposes same and urges that the motion is moot, or should be denied, in view of the filing herewith of Opposer's Amended Notice of Opposition, which cures the alleged defects of, e.g., not numbering the paragraphs of the Notice. This filing is permitted under Rule 15, F.R.Civ.P., in that no Answer has yet been filed by Applicant.

No dismissal sanction as in the cited case is appropriate, as Opposer's filing was certainly sufficient to give Applicant notice of the issues involved. Further, the TTAB has found the original Notice sufficient to initiate this Opposition. Indeed, house counsel of Applicant has telephoned counsel for Opposer regarding the opposition, clearly knowing what the issues are.

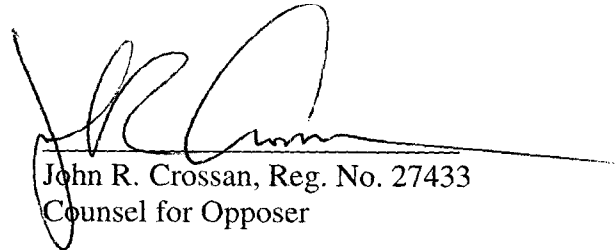
Matters originally stated have been updated, such as issuance of the registration for the BLUEAIR word mark on October 29. This Amended Notice is ripe for Answer.

Rejection of the motion for dismissal, and resetting of the times for the opposition accordingly, are respectfully solicited.

BlueAir, Inc.

December 12, 2002

By:



John R. Crossan, Reg. No. 27433
Counsel for Opposer

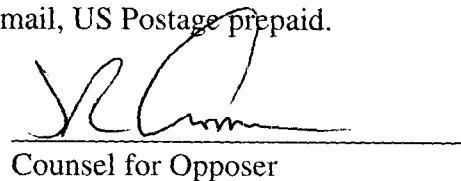
CHAPMAN AND CUTLER
111 W. Monroe St., #1700
Chicago, IL 60603
312/845-3420
fax: 312/803-5299
crossan@chapman.com

Certificate of Service

A true copy of the foregoing document is being served on Applicant's counsel, addressed to:

Timothy P. Fraelich, Esq.
Deborah B. Uluer, Esq.
JONES DAY REAVIS & POGUE
North Point, 901 Lakeside Avenue
Cleveland, OH 44114-1190

this 12th day of December, 2002, via first class mail, US Postage prepaid.



Counsel for Opposer

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BLUEAIR, INC.,)	
)	Opposition no. 91153135
<i>Opposer,</i>)	
)	
vs.)	Application SN 76/085,778
)	
HAMILTON BEACH / PROCTOR SILEX,)	Published July 30, 2002
)	
<i>Applicant.</i>)	
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AMENDED NOTICE OF OPPOSITION TO REGISTRATION

BOX TTAB NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington VA 22202-3513

For its Amended Notice and Opposition to Registration of the **TrueAir** mark to Applicant, Opposer states as follows under 37 CFR §§ 2.116 and Rules 10 and 15, F.R.Civ.P., no Answer having yet been filed by Applicant.

1. BLUEAIR, Inc., a corporation of Delaware, with a principal place of business at 435 N. LaSalle St., Suite 410, Chicago, IL 60610, USA, believes that it would be damaged by the registration of the captioned mark of this application on the Principal Register of the US Trademark Office. Opposer paid with its original Notice of Opposition the \$300 fee for initiating this Opposition, in the one class of the application, and filed that paper within 30 days after publication of the mark on July 30, 2002.

2. Opposer Blueair, Inc., is a subsidiary of and the exclusive licensee for the US and Canada of the owner, Blueair AB, of the registered trademark **BLUEAIR AND DESIGN**, registration no. 2,467,700, in class 11 (Ex. A to the original Notice), and of the registered trademark

BLUEAIR, no. 2,642,748 also in class 11 (issued on October 29, 2002, from Ex. B of the original Notice). The goods are stated as "aircare products, namely, household air cleaners, air purifying units for domestic and commercial use, air conditioners, humidifiers, and dehumidifiers".

3. Opposer has been importing and selling such air care products under its **Blueair and design** and its **BLUEAIR** trademarks in commerce and in interstate commerce of the United States since at least as early as January, 1996, and it is using these marks in commerce and in interstate commerce of the United States at this time. Exhibits C and D to the original Notice are specimens of use of the marks on Opposer's goods as registered or applied for, as follows:

- C: a reduced-size copy of one printed edge of a filter cartridge, showing both the **Blue-air and design** and the **BLUEAIR** word trademarks as used on the goods; and
- D: a copy of another printed edge of the filter cartridge, showing the **BLUEAIR** word mark as used on the goods.

Exhibit E to the original Notice is a page print from Opposer's dot-com web site, showing both **Blueair** trademarks as used and promoted for the goods of the two registrations throughout the United States.

4. Applicant's mark **TrueAir** (stylized) is used for exactly the same goods as are the marks of Opposer: "atmosphere treatment machines in the nature of air purifying units for industrial, commercial, and domestic use, and replacement parts therefor" (Ex. F to the original Notice). Applicant has operated a web site trueair.com (Ex. G to the original Notice) only since early 2001 (Ex. H to the original Notice), at which information about its air conditioners, humidifiers, air cleaners, and odor eliminators are described and promoted under the mark of the application (Ex. G).

5. Applicant's mark **TrueAir** is confusingly similar to Opposer's previously registered marks **Blueair and design** and **BLUEAIR**; the marks are used on exactly the same goods and they move in exactly the same channels of commerce for sale to exactly the same consumers. Opposer was the first to use its marks in the United States, in early 1996, and was the first to apply

for and to register its design mark with the prominent word portion, in May 2000 and issued in July 2001 - versus the Intent-To-Use case filed only in July 2000 by Applicant.

6. The first words or portions of the marks, TRUE and BLUE, have the same number of letters, they rhyme, and their end letters are the same; this first portion is set apart by the capital A in Applicant's stylized mark and is separately pronounced in both Opposer's and Applicant's marks. TRUE BLUE is a standard onomatopoeic device familiar to all Americans (*see* Ex. I to the original Notice, a TM Office web site print of 54 "live" records for marks with both TRUE and BLUE, most with TRUE BLUE together). *See also* Ex. J to the original Notice, TM Office web site prints of three registered marks using TRUE BLUE for goods in class 11 and/or for air processing goods. Thus, the dominant words of the two marks are easily confused for one another, whether marks using them are examined closely or not.

7. The suffix AIR portions of the word marks are identical to one another and contribute to the similarity of the marks as used on the goods of Applicant and of Opposer. AIR is disclaimed by Applicant, but its presence in the mark adds to the confusing similarity of the two marks on the similar goods.

8. Applicant and Opposer are competitors in the home and commercial air treatment markets.

9. Consumers are very likely to be unable to distinguish between the two marks but will be very likely to be confused as between the marks of the different companies; they likely will buy Applicant's goods when they are seeking to buy Opposer's **BLUEAIR** goods, especially if a full line of **TrueAir** products is released as contemplated by Applicant's web site (*see* Ex. G to the original Notice, left panel) and the application for registration.

10. Opposer will be damaged by the confusion between the marks, and by any registration of the mark to Applicant as sought in the published application.

WHEREFORE:

A. This Opposition case should be continued for consideration and proof of the facts and law of same, and

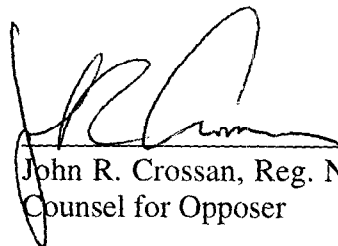
B. Registration should be refused to Applicant.

All correspondence of the Office and Applicant should be directed to undersigned counsel for BlueAir, Inc. This Amended Notice and Opposition is being filed in an original and a duplicate, and a true copy is being served by mail on Applicant within the time for response (including mailing time) to the pending Motion to Dismiss.

BlueAir, Inc.

December 12, 2002

By:


John R. Crossan, Reg. No. 27433
Counsel for Opposer

CHAPMAN AND CUTLER
111 W. Monroe St., #1700
Chicago, IL 60603
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fax: 312/803-5299
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Exhibits to the Original Notice Supporting this Amended Notice of Opposition

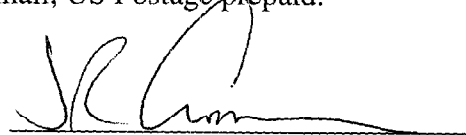
	<u>No.</u>
BLUEAIR AND DESIGN Trademark Registration 2,467,700	A
BLUEAIR Published Trademark Application	B
BLUEAIR and BLUEAIR AND DESIGN tms as used in commerce	C
BLUEAIR tm as used in commerce	D
BLUEAIR.COM web site, advertising and promoting Opposer's goods	E
TrueAir (stylized) trademark, as published for opposition	F
TrueAir (stylized) tm as used on Applicant's web site pages	G
WhoIs web site report on creation and ownership of trueair.com domain	H
Trademark Office web site report on "true" and "blue" words in all live marks	I
Trademark Office web site prints of registered marks with TRUE BLUE words, for goods in Class 11 and/or for air handling products	J

Certificate of Service

A true copy of the foregoing document is being served on Applicant's counsel, addressed
to:

Timothy P. Fraelich, Esq.
Deborah B. Uluer, Esq.
JONES DAY REAVIS & POGUE
North Point, 901 Lakeside Avenue
Cleveland, OH 44114-1190

this 12th day of December, 2002, via first class mail, US Postage prepaid.



Counsel for Opposer

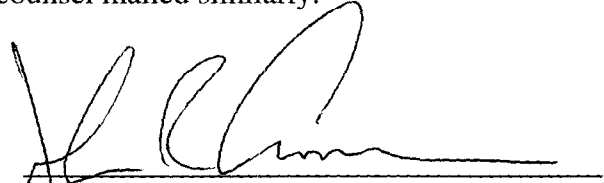
12-16-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #30

CERTIFICATE OF MAILING

TTAB

I hereby certify that the original and one copy of these documents are being deposited with the United States Postal Service in an envelope addressed to the TTAB, c/o Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on this 12th day of December, 2002, with a copy also designated for Applicant's counsel mailed similarly.


Counsel for Opposer

TRADE MARK AND
COUNCIL
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